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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,703	07/09/2003	Jonathan J. Oliver	PA3626US	1579

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EXAMINER
DUONG, OANH L

ART UNIT	PAPER NUMBER
2155	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 July 2003</u>.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date *09/08/03, 09/12/03, & 11/20/06*.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4.   Claims 1, 20 and 21 appear to be an abstract idea rather than a practical application of the idea. Claims 1, 20 and 21 does not require any physical transformation and the invention as claimed does not produce a useful concrete and tangible result. Specifically, the claimed invention does not appear to produce a useful, concrete and tangible result because merely determining a classification of the message is nothing more than a thought or computation within a processor. It fails to use or make available for use the result of the determination to enable its functionality and usefulness to be realized (see M.P.E.P §2106). Additionally, the asserted practical application in Applicant's specification is "classifying electronic messages" (for example, applicant's specification in page 13 line 18). The practical application is not explicitly recited in the claim nor does it flow inherently therefrom. Therefore, claim 1, 20 and 21 appears non-statutory.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6.   Claims 19, and 11-21 are rejected under 35 U.S.C. 102(e) as being anticipated

by Patel et al. (hereinafter, Patel), US 7,149,778 B1.

Regarding claim 1, Patel teaches a method for classifying a message

comprising:

receiving the message (col. 8 lines 39-40);

identifying all items of a certain type in the message (col. 5 lines 48-55);

determining whether each of the items meets a criterion (col. 9 lines 7-16); and

in the event that all the items are determined to meet the criterion, determining a classification of the message (col. 8 lines 35-44).

Regarding claim 2, Patel teaches a method for classifying a message as recited in Claim 1 wherein determining whether each of the items meets the criterion includes determining whether each of the items is acceptable (col. 1 lines 1-6).

Regarding claim 3, Patel teaches a method for classifying a message as recited in Claim 1 wherein the items include a distinguishing property (col. 9 lines 7-16).

Regarding claim 4, Patel teaches a method for classifying a message as recited in Claim 1 wherein the items include a contact point (col. 9 lines 7-16).

Regarding claim 5, Patel teaches a method for classifying a message as recited in Claim 1 wherein the items include a contact point that is a universal resource locator (URL) (col. 18 lines 47-58).

Regarding claim 6, Patel teaches a method for classifying a message as recited in Claim 1 wherein the items includes a contact point that is a phone number (col. 18 lines 50-53).

Regarding claim 7, Patel teaches a method for classifying a message as recited in Claim 1 wherein the items includes a contact point that is an address (col. 3 lines 52-58).

Regarding claim 8, Patel teaches a method for classifying a message as recited in Claim 1 wherein determining a classification of the message includes classifying the message as a non-spam message (col. 9 lines 22-24).

Regarding claim 9, Patel teaches a method for classifying a message as recited in Claim 1 wherein determining whether each of the items meets the criterion includes determining whether the item exists in a database of acceptable items (col. 9 lines 1-3).

Regarding claim 11, Patel teaches a method for classifying a message as recited in Claim 1, wherein determining whether each of the items meets the criterion includes deriving a signature from the item, and determining whether the signature exists in a database of acceptable signatures (col. 9 lines 53-63).

Regarding claim 12, Patel teaches a method for classifying a message as recited in Claim 1, in the event that the signature is determined not meet the criterion, further comprising processing the message to determine its classification (col. 9 line 64-col. 10 line 6).

Regarding claim 13, Patel teaches method for classifying a message as recited in Claim 1, wherein:

determining whether each of items meets the criterion includes determining whether the item exists in a database of acceptable items (col. 9 lines 53-63).

teach the database is updated by a registration process (col. 19 lines 5-7).

Regarding claim 14, Patel teaches a method for classifying a message as recited in Claim 13, wherein the registration process includes:

receiving a registration message, determining whether the registration message is from an acceptable source, and in the event that the registration message is from an acceptable source, extracting an item from the message; and adding an entry derived from the item to the database (col. 5 lines 4-16).

Regarding claim 15, Patel teaches a method for classifying a message as recited in Claim 13, wherein determining whether the message is from an acceptable source includes checking a certificate associated with the message (i.e., col.5 line 64-col. 6 line 10).

Regarding claim 16, Patel teaches a method for classifying a message as recited in Claim 13, wherein the database is further maintained by performing a test to determine whether the message is spam (col. 8 lines 27-34).

Regarding claim 17, Patel teaches a method for classifying a message as recited in Claim 1, wherein: determining whether each of items meets the criterion includes determining whether the item exists in a database of acceptable items, and the database is updated by aggregating user inputs (col. 5 lines 4-16).

Regarding claim 18, Patel teaches a method for classifying a message as recited in Claim 17, wherein aggregating user inputs includes:

extracting an item from a user classified messages (col. 19 lines 15-16);

updating the state of the item based on user classification (col. 19 lines 16-17).

Regarding claim 19, a method for classifying a message as recited in Claim 1 wherein:

determining whether each of the items meets a classification criterion includes determining whether the item exists in a database of acceptable items (col. 9 lines 9-10); and

the database is updated by post-processing stored messages (col. 19 lines 15-17).

Regarding claim 20, this claim recites a system for classifying a message of method claim 1, discussed above, same rationale of rejection is applicable.

Regarding claim 21, this claim comprises a computer program product for classifying a message of the method claim 1, discussed above, same rationale of rejection is applicable.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patel, in view of Malcolm et al. (hereinafter, Malcolm), US 2003/0041280 A1.

Regarding claim 10, Patel teaches a method for classifying a message as recited in Claim 1.

Patel does not explicitly teach determining whether each of the items meets the criterion includes reducing the item to its canonical equivalent and computing a signature based on the canonical equivalent.

Malcolm teaches method and system wherein object information transmitted using a computer network is cached (abstract). Malcolm teaches reducing the item to its canonical equivalent and computing a signature based on the canonical equivalent (page 5 paragraph [0070]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Patel to reduce the item to its canonical equivalent and computing a signature based on the canonical equivalent as taught by Malcolm. One would be motivated to do so to maximize efficiency of the system (Malcolm, page 1 paragraph [0010] line 3).

9.　　　Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 9:30PM - 6:00PM.
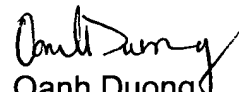
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Oanh Duong
March 31, 2007